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EXAMINER


ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/891,840	<b>Applicant(s)</b> IKEDA, KIYOKAZU	
	<b>Examiner</b> Nicholas D. Rosen	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9 is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15-23 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 8, 10, 13, 14, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-29 have been examined.

#### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: On page 4, line 13, "severs" should be "servers".

Appropriate correction is required.

#### ***Claim Objections***

The concluding phrase of claim 1, "have been sold simultaneously" is not precisely an error, but is unidiomatic English in context. Examiner suggests amending it to "are sold together to said user" or "are sold simultaneously to said user".

Claim 8 is objected to because of the following informalities: "said vehicle" lacks antecedent basis. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: In the thirteenth line of claim 10, "severs" should be "servers". Appropriate correction is required.

Claim 18 is objected to because of the following informalities: "said vehicle" lacks antecedent basis. Appropriate correction is required.

Claims 21-25 are objected to because of the following informalities: In the twentieth line of claim 21 (the tenth line on page 13 of the emended claims), "searched for based said purchase" should be "searched for based on [or upon] said purchase", if Examiner has followed the syntax correctly. Appropriate correction is required.

Claim 23 is objected to because of the following informalities: In the fourth and fifth lines, "tangible product sales server that sells an intangible product" should be "tangible product sales server that sells a tangible product". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### **Claim 11, 12, 15, 16, 17, and 18**

Claims 11, 12, 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (U.S. Patent Application Publication 2001/0037265) in view of official notice. As per claim 11, Kleinberg discloses a cooperative sales system in which a plurality of servers interconnected via a network cooperatively sell a (perhaps) tangible product and an intangible product associated with each other, having: a user

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terminal apparatus connected to said network for transferring and receiving data about said sale with said plurality of servers and displaying and inputting said data based on an operation performed by a user of said user terminal apparatus (paragraphs 19, 20, and 26); an intangible product sales server connected to said network for transferring and receiving said data about said sale of said intangible product with said user terminal apparatus and signing a sales contract with said user about said intangible product (paragraphs 25-29, signing a sales contract, etc., being implicit from doing business); and a second product sales server connected to said network for transferring data about said sale of a second product with said user and signing a sales contract with said user about said second product (paragraphs 19, 20, and 26). Kleinberg does not disclose that the second sales server is a tangible sales server (his second server sells intangible insurance), but official notice is taken that it is well known to sell tangible products over the Internet. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for one of the servers to be a tangible product sale server, for the obvious advantage of profiting from the sale of tangible products.

Kleinberg discloses that the user terminal apparatus comprises terminal communication means (paragraphs 4, 16, 17, and 18), display means (paragraphs 19, 20, and 26), and operator means (paragraphs 19, 20, 38, 39, and 40), the means being inherent from the disclosed actions. Similarly, given what is done in Kleinberg's system, control means for controlling the various means for enabling these things to be done is held to be inherent. Kleinberg discloses that the first intangible product sales server

comprises: intangible server communication means for transferring and receiving said data with an other device connected to said network (paragraphs 25-29). Kleinberg is not fully explicit about the first intangible product sales server comprising product data storage means and information storage means for storing intangible product data about the user supplied from the user terminal apparatus, but this is obvious from the activity of the first server in Kleinberg, in that it sells travel planning and reservation services, which implies storing data on what plane tickets, hotel rooms, etc., are available, and who has ordered or reserved what products and services. Server control for enabling the various operations in Kleinberg to be performed is likewise obvious.

Kleinberg further discloses that the second product sales server discloses communication means for transferring and receiving said data with an other device connected to said network (paragraphs 25-30 and 32); product data storage for storing product data about the second product, and user information storage means for storing second product data about the user (paragraphs 32, 33, 36, and 38-40). Server control for enabling the various operations in Kleinberg to be performed is likewise obvious from Kleinberg's disclosure.

As per claim 12, Kleinberg discloses that when a purchase order for said second product by a user has been received by the communication means, from the first intangible product sales server, the second server control means executes a second product sales contract based on user information stored by the second server (paragraphs 29, 34, 35, and 40 [payment of sales commissions implies that actual sales take place]).

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As per claim 15, Kleinberg does not disclose that control means of the second server transmits user information to a service providing server connected to said network for installing a tangible product on a vehicle of the user, but official notice is taken that products for installation on a vehicle of a user are well known (brake pads, for example). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the second server to transmit user information to a service providing server connected to the network for installing said tangible product on a vehicle of the user, for the obvious advantage of arranging for a vehicle-related product to be installed on a vehicle of the user.

As per claim 16, Kleinberg does not disclose that the control means of the second server selects said service providing server based on user information stored in the second server, but official notice is taken that it is well known to select a service provider based on stored user information (e.g., selecting a convenient physical store or other service provider for a remote customer based on information about that customer's physical location/home address stored in a server). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the second server to select said service providing server based on user information stored in the second server, for the obvious advantage of selecting a service providing server based on the user's geographic location or other user information that makes some potential service providers evidently more suitable than others.

As per claim 17, Kleinberg discloses that an intangible product for sale by an intangible product sales server is an automobile insurance product (paragraphs 20 and 32).

As per claim 18, Kleinberg does not disclose that a tangible product for sale is at least one of a car navigating system and a car safety device to be installed on a vehicle covered by said automobile insurance product, but official notice is taken that car navigating systems and car safety devices to be installed on vehicles covered by automobile insurance are well known (see, for example, the article "Online Auto Parts Business Puts Brakes on the Web," and Kozak, U.S. Patent 6,415,226). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the tangible product to be at least one of a car navigating system and a car safety device to be installed on a vehicle covered by the automobile insurance product, for the obvious advantages of profiting from the sale of car navigating systems and/or car safety devices, and advertising them to people interested in buying automobile insurance, or people who have bought automobile insurance, and these being people likely to own automobiles.

#### **Claims 19 and 20**

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (U.S. Patent Application Publication 2001/0037265) in view of the article "Online Auto Parts Business Puts Brakes on the Web," hereinafter "Online Auto Parts". As per claim 19, Kleinberg discloses a product cooperative purchase apparatus connected to a network for purchasing both an intangible product and a tangible product



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from an intangible product sales server and a (perhaps) tangible product sales server, respectively, connected to said network, comprising: communication means for communicating with one of said servers via said network (paragraphs 4, 16, 17, and 18); display means for displaying data supplied from said intangible product sales server (paragraphs 19, 20 and 26; display means being inherent from the display of information to the user); operator means for a user of said product cooperative purchase apparatus to input a request for a desired intangible product, said inputted request being transmitted to said intangible product sales server (paragraphs 19, 20, 38, 39, and 40; the operator means being inherent from the operation of purchasing an insurance policy). Similarly, given what is done in Kleinberg's system, control means for controlling the various means for enabling these things to be done is held to be inherent. Kleinberg does not expressly disclose that the apparatus includes a tangible product sales server (insurance is an intangible product, and the other sales server may be for selling travel planning and reservation services, which can also be viewed as intangible). However, *imprimis*, nothing in the body of claim 19 refers to a tangible product, or the tangible product sales server, and so nothing in the body of the claim breathes life and weight into this phrase from the preamble. *Secundus*, even if "tangible product sales server" is to be regarded as a limitation of claim 19, tangible product sales servers are well known, as taught by "Online Auto Parts," which teaches a website, and therefore a server, for selling brake pads, which are tangible products (especially first two paragraphs of article). The [www.discpads.com](http://www.discpads.com) website of "Online Auto Parts," and the insurance website of Kleinberg would both be on the Internet, and therefore

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"connected to said network," as claim 19 does not recite any other interaction between the tangible and intangible product sales servers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for one of the servers to be a tangible product sale server, for the obvious advantage of profiting from the sale of tangible products.

As per claim 20, Kleinberg discloses that said intangible product can be an automobile insurance product (paragraphs 20 and 32). Kleinberg does not disclose that said tangible product is at least one of a car navigating system and a car safety device to be installed on a vehicle covered by said automobile insurance product, but "Online Auto Parts" discloses a car safety device suitable for installation in an insured vehicle (especially first two paragraphs of article). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the tangible product to be at least one of a car navigating system and a car safety device to be installed on a vehicle covered by the automobile insurance product, for the obvious advantages of profiting from the sale of car navigating systems and/or car safety devices, and advertising automobile insurance products to people interested in buying tangible vehicle-related products, and therefore likely to own automobiles.

### **Claims 21, 22, and 23**

Claims 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (U.S. Patent Application Publication 2001/0037265) in view of official notice. As per claim 21, claim 21 is rejected on at least the same grounds as claim 11 above.

As per claim 22, Kleinberg discloses transmitting user information from a first product sales server to a second product sales server (paragraphs 25-30, especially 28).

As per claim 23, Kleinberg discloses that the first product sales apparatus transmits to the user terminal apparatus link information for linking to the second product sales server (paragraph 26).

**Claim 26-29**

Claims 26, 27, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (U.S. Patent Application Publication 2001/0037265) in view of official notice. As per claim 26, claim 26 is rejected on at least the same grounds as claim 11 above.

As per claim 27, Kleinberg discloses the second product sales server transmitting retrieved product data to said user terminal apparatus operated by said user to execute a sales process on the second product through said user terminal apparatus (paragraphs 29, 34, 35, and 40 [payment of sales commissions implies that actual sales take place]).

As per claim 28, Kleinberg discloses that when said sales process has been executed, the second product sales server transmits sales information indicative of sales of the second product to said first product sales server, presumably through said communication means via said network (paragraphs 29, 34, 35, and 40 [payment of referral/sales commissions is held to comprise transmission of information that sales have taken place]).

As per claim 29, claim 29 is closely similar to claim 18, and rejected on essentially the same grounds.

***Allowable Subject Matter***

Claims 1-7 and are allowed; claim 8 would be allowed if rewritten to overcome the informality objected to above.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Kleinberg (U.S. Patent Application Publication 2001/0037265), discloses a sales method in which at least an intangible product sales server for selling an intangible product and a (perhaps) tangible product sales server for selling a (perhaps) tangible product are interconnected by a network for cooperatively selling said intangible product and (perhaps) a tangible product upon request from a user terminal operated by a user, comprising the steps of: searching an intangible product sales server for an intangible product desired by said user based on an operation performed through said user terminal, and displaying a search result on a user terminal (paragraphs 17-20 and 38-40). Kleinberg does not disclose displaying on said user terminal information about a tangible product associated with said retrieved intangible product, said tangible product being offered for sale by said tangible product sales server, but does disclose doing pretty much this for a second intangible product (insurance) for sale by an intangible product sales server, the second intangible product (insurance) being related to a first intangible product (travel planning and reservation

services). Given that tangible product and servers for selling them are well known, this difference from Kleinberg would not be judged sufficient to make claim 1 allowable.

Kleinberg does not disclose discounting a sales price of one of said intangible product and said tangible product when said intangible product and said tangible product displayed on said user terminal are sold simultaneously. Discounts in general are known, but the particulars of discounting the price of one of a tangible and an intangible product when they are sold together do not appear to be taught in the prior art of record. Kozak (U.S. Patent 6,415,226), for example, teaches discounting insurance for drivers who use automobile navigation and safety equipment (column 15), but does not teach or suggest selling the discounted insurance in combination with the navigation and safety equipment, still less doing so in e-commerce. The anonymous article "PNI Teams with Digital Vision" teaches letting users "order CDs at attractive discounts" after downloading "taster" images, but does not teach or suggest that the discounts are conditional on buying the CD's (tangible products) and the images (intangible products) together.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim 10 is objected to as because of the minor informality objected to above, but would be allowable if rewritten to overcome the objection.

The following is a statement of reasons for the indication of allowable subject matter: The reasoning is essentially the same as for claim 1 above.

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Kleinberg (U.S. Patent Application Publication 2001/0037265), discloses or makes obvious the limitations of claims 11 and 12, as set forth above; Kleinberg further disclose transmitting sales transformation about a sales contract of the second product server to the first product server through said network (implied by paying sales commission, as Kleinberg discloses. However, Kleinberg does not disclose changing a sales price of at least one of the intangible and the tangible product upon reception of said sales information from said second sales server. Discounts and other price changes in general are known, but the particulars of changing a price of one of a tangible and an intangible product upon reception of said sales information from said second sales server do not appear to be taught in the prior art of record. Kozak (U.S. Patent 6,415,226), for example, teaches discounting insurance for drivers who use automobile navigation and safety equipment (column 15), but does not teach or suggest selling the discounted insurance in combination with the navigation and safety equipment, still less doing so in e-commerce. The anonymous article "PNI Teams with Digital Vision" teaches letting users "order CDs at attractive discounts" after

downloading "taster" images, but does not teach or suggest that the discounts are conditional on buying the CD's (tangible products) and the images (intangible products) together, or that the price of one product is changed based on reception of sales information from a second sales server.

Claims 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 24 and 25 are allowable on essentially the same grounds set forth for claims 13 and 14 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Underwood et al. (U.S. Patent 5,873,066) discloses a system for electronically managing the underwriting of an insurance policy. Gamble et al. (U.S. Patent 6,163,770) discloses discounting the premiums for one insurance policy based on another insurance policy. Henson (U.S. Patent 6,167,383) discloses providing customer-configured machines at an Internet site and recommending add-ons, see columns 9 and 10). Osborn et al. (U.S. Patent 6,182,048) disclose risk-based pricing of a vehicle warranty insurance policy. Andrews (U.S. Patent 6,285,986) disclose selling a bundle of products as a unit. Jacobi et al. (U.S. Patent 6,317,722) discloses the use of

electronic shopping carts to generate personal recommendations. Kozak (U.S. Patent 6,415,226) discloses a method and system for providing safe routes using a navigation system. Downs et al. (U.S. Patent 6,754,609) disclose a secure electronic content management system, including selling a combination of physical and downloadable merchandise (see columns 68-69 and 76-77).

Wallis et al. (U.S. Patent Application Publication 2001/0051884) discloses a method and system for controlling warranty-related data and services.

Dorak et al. (WO 00/08909 A2) disclose a system for tracking end-user electronic content usage.

Emling ("The Price of Protection") discloses insurance discounts for people who install devices like deadbolt locks and burglar alarms. Martin ("Survival of the Fittest") discloses bundling tangible equipment with services. The anonymous article, "PNI Teams with Digital Vision," discloses a website for selling CD's of images. Schonfeld ("The Amazon.com of Cyberbabies") discloses selling car safety equipment online. The anonymous article, "Biz-2-Biz Q&A" discloses searching for digital products online. Roush ("Bendix Sells Brake Parts Online") discloses selling auto safety equipment online.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is



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currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

October 1, 2004